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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,965	06/24/2003	Benedict Anthony Gomes	Google-4/CON1(GP-009-01-	1058

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STRAUB & POKOTYLO  
620 TINTON AVENUE  
BLDG. B, 2ND FLOOR  
TINTON FALLS, NJ 07724

EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/602,965	Applicant(s) GOMES ET AL.	
	Examiner Cheyne D. Ly	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-52 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/24/03</u> . | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. Claims 46-52 are examined on the merits.

#### **CLAIM REJECTIONS - 35 U.S.C. § 112, FIRST PARAGRAPH**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 46, 50, and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. New Matter Rejection.
4. In regard to claims 46, 50, and 52, the limitations of "adding... final search research," step 2), have not been found in the instant specification.

#### **Double Patenting**

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d

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- 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
8. Claims 46-52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3 and 14 of U.S. Patent No. US006615209B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent application claims to a genus which is anticipated by a patent claim to a species within that genus.
9. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at

1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

10. Specific to claims 46, 50, and 52, it is noted that the U.S. Patent No. US006615209B1 does not explicitly disclose the limitation of “adding...final search research” in step 2). However, the required limitation of “adding...final search research” in step 2) is an obvious variant of the invention disclosed in said patent because it is an obvious alternative to steps i) and ii) of claims 3 and 14 of U.S. Patent No. US006615209B1.

#### **Claim Rejections - 35 USC § 102**

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 46, 49, and 51 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by

Takata et al. (US006526400B1) (Takata hereafter).

13. In regard to claim 46, Takata discloses a method for processing search results generated based on a query (claim 12) comprising:

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- a. Accepting the search results (claim 13);
- b. Accepting keyword information extracted from the query (claim 12); and
- c. Generating a set of final search results from the accepted using the accepted keyword information (column 17, lines 63, to column 18, line 3).

14. In regard to claims 49 and 51, Takata discloses a computer-readable medium and apparatus (claim 10) for the above-cited method.

### **Claim Rejections - 35 USC § 103**

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
17. Claims 47, 48, 50, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takata et al. (US006526400B1) (Takata hereafter) as applied to claims 46, 49, and 51 above, and further in view of Thomson (US 5634051 A).

18. Takata describes the claims 46, 49, and 51 as cited above. However, Takata does not describe steps 1) and 2) required by claim 47.
19. Thomson describes an improvement for reducing the amount of time and cost required retrieving relevant results (Abstract). One of ordinary skill in the art at the time of the invention would have been motivated by Thomson to improve the method and apparatus of Takata to reduce the amount of time and cost required to retrieve relevant results.
20. In regard to claim 47, Thomson describes determining, using the accepted keyword information, whether or not a candidate search result is similar to a search result already in the set of final results, and if it is determined that the candidate search result is similar to a search result already in the set of final search results, then not adding the candidate search result to the set of final search results (column 4, line 55, to column 5, line 12, and column 10, lines 1-16, and lines 31-48).
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make and use the method and apparatus of Takata and Thomson to reduce the amount of time and cost required to retrieve relevant results.
22. In regard to claims 48, 50, and 52, Thomson describes determining, using the accepted keyword information, whether or not a candidate search result is similar to a search result already in the set of final results, and adding the search results to the set of final search results only if it is determined that the candidate search result is not similar to any search results already in the set of final search result (column 4, line 55, to column 5, line 12, and column 10, lines 1-16, and lines 31-48). It is noted that the citation above does not explicitly describe the “adding...only if it is...not similar to any search results...”

Thomson describes a method which “at the time of loading duplicate documents from the multiple sources preferably are identified and removed so that the results from a search query will not include redundant or duplicate document...” Therefore, Thomson suggests the loading of non-redundant search results or search results that is not similar to any search results already in the final set of search results.

23. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make and use the method and apparatus of Takata and Thomson to reduce the amount of time and cost required to retrieve relevant results.

### CONCLUSION

24. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables

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applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

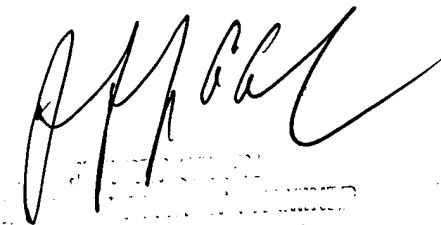
25. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (571) 272-4146.

C. Dune Ly / *CDL*  
Patent Examiner  
1/30/06

A handwritten signature in black ink, appearing to read 'CDL', is written over a faint, rectangular stamp. The signature is fluid and cursive.